

REMARKS

Summary of the Office Action

Claims 1-3 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,543 to *Udagawa, et al.*, ("*Udagawa*"), in view of admitted prior art.

Claims 4 and 5 remain rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Summary of the Response to the Office Action

Applicant cancels claims 4-5 without prejudice or disclaimer. Claim 1 is amended. Applicant respectfully submits that the amended features of the present invention are not taught or suggested by the applied references of record. Accordingly, claims 1-3 are presently pending.

Information Disclosure Statement

Applicant submitted an Information Disclosure Statement on November 9, 2007. Applicant thanks the Examiner for acknowledging the Information Disclosure Statement by initialing the PTO 1449 form and returning a copy to Applicant.

All Subject Matter Complies With 35 U.S.C. § 112, first paragraph

Applicant has canceled claims 4 and 5 in order to expedite the prosecution of this case. Applicant respectfully submits that the rejection of claims 4-5 under 35 U.S.C. § 112, first

paragraph, is moot. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Applicant has amended claim 1 and canceled claims 4 and 5 in order to expedite the prosecution of this case. Applicant respectfully submits that the amendment to claim 1 does not narrow the intended scope of the claim, and therefore, Applicant does not intend to relinquish any subject matter by these amendments. Applicant respectfully submits that claims 1-3 meet all the requirements of 35 U.S.C. § 112, as amended. Thus, the rejection of claims 1-3 under 35 U.S.C. § 112, second paragraph, is moot. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Claims Comply With 35 U.S.C. § 103(a)

Claims 1-3 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,791,543 to *Udagawa, et al.*, (“*Udagawa*”), in view of admitted prior art. Applicant respectfully traverses the rejection for at least the following reasons.

The Office Action has not established a *prima facie* case of obviousness at least because *Udagawa*, whether alone or in combination, fails to teach or suggest all the recited features of newly amended independent claim 1. Newly amended independent claim 1 recites, in part, “a fixing plate linearly slidable with respect to the fixing pin and engagable with the fixing pin to

lock the table link in a paper-pressing state . . . wherein the table link and the fixing plate are separate members, and the table link and the fixing plate are relatively movable to each other.” These features are not found in *Udagawa*. Thus, *Udagawa* fails to teach or suggest at least these features of newly amended independent claim 1.

The Office Action states in section 8 on page 4, that *Udagawa* fails to disclose “the table link and fixing plate being separate members.” The previous Office Action asserted member 152 of *Udagawa* was the claimed “table link,” and member 152A of *Udagawa* was the claimed “fixing plate.” Nevertheless, the current Office Action takes Official Notice of the corresponding structure in *Udagawa* may be separated into two parts as in the present invention. However, these assertions are impossible because members 152 and 152A are portions of the same member and are integrated. See, for example, Figs. 3 and 17 of *Udagawa*. Claim 1 requires that the table link and fixing plate be separate members and the fixing plate be capable locking the table link in a paper-pressing state. It is impossible for the fixing plate to lock the table link if they are integrated portions of the same member, as is the case in *Udagawa*.

Further, newly added features “wherein the table link and the fixing plate are separate members, and the table link and the fixing plate are relatively movable to each other,” further delineate that the alleged table link 152 and alleged fixing plate 152A of *Udagawa* cannot make obvious claim 1. In contrast, in the present invention, Fig. 2 shows the table link (3) and the fixing plate (5) are separate members and are relatively movable to each other. Thus, *Udagawa* cannot make obvious the present invention.

The Office Action erroneously states that the rejection of claims 1-3 is also in view of

Admitted Prior Art (APA), but then indicates that the Examiner is taking Official Notice that it would have been obvious to form a structure as two separate parts. However, this Official Notice is also defective because "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." See M.P.E.P. § 2144.03. The Official Notice taken is not appropriate because the Examiner's alleged facts are not well-known or common knowledge within the art. Further, the table link 3 and fixing plate 5 of the present invention (Fig. 1) cannot be the alleged table link 152 and alleged fixing plate 152A of *Udagawa* because they accomplish very different purposes and so must be separated. That is, the table link 3 connects the table 8 (and movable clincher) to the main body of the stapler, while the fixing plate 5 is utilized in combination with other parts to place the table link 3 in a locked position to improve stapler performance. Thus, the table link 3 and the fixing plate 5 must be separate components in order to achieve the desired performance.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Udagawa*, whether taken alone or in combination, fails to teach or suggest each feature of newly amended independent claim 1, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Additionally, Applicant respectfully submits that dependent claim 2-3 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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